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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,087	02/22/2000	Paul A. Smith	EVS-P-99-017	2705
7590	01/11/2005			EXAMINER WALCZAK, DAVID J
Patents+TMS A Professional Corporation 1914 N Milwaukee Avenue 3rd Floor Chicago, IL 60647			ART UNIT 3751	PAPER NUMBER
			DATE MAILED: 01/11/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/510,087	SMITH, PAUL A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David J. Walczak	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 21 December 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-9,11-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-8,12,13 and 20 is/are withdrawn from consideration.
- 5) Claim(s) 9,11,14 and 21 is/are allowed.
- 6) Claim(s) 15-17 is/are rejected.
- 7) Claim(s) 19 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin et al. (hereinafter Martin). Fischer discloses a marking device having a barrel and sheath wrapped around the barrel wherein the sheath overlaps onto itself. Although the Fischer reference does not disclose an end cap and a connecting chain for securing the marking device, attention is directed to the Martin reference, which discloses another marking instrument 16 wherein an end cap 15 and a connecting chain 14 are used to secure the device when not in use. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such an end cap and chain onto the marking device in the Fischer reference in order to enable that device to be secured when not in use.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin and Jones. As discussed supra, Fischer and Martin disclose the claimed marking instrument, sheath, end cap and connecting lead. Further, the method as claimed is inherent in the usage of the device discussed above. Although the sheath in the Fischer reference is not disclosed as being coated with an antimicrobial

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substance, attention is directed to the Jones reference, which discloses another sheath for the marking instrument wherein the sheath is coated with such a substance in order to render the device sanitary (Although the Jones reference discloses that the sheath is molded with the substance and not coated with the substance, in order for the substance to be effective, some of the substance must be present on the outside surface of the sheath and thereby the sheath is considered to be "coated" with the substance. Further, the Applicant has disclosed on page 7, lines 2-17 that the sheath can either be coated with the substance or the substance can be contained within the material of the sheath). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide such a substance onto the sheath in the Fischer device in order to render the sheath sanitary.

#### ***Allowable Subject Matter***

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9, 11, 14 and 21 are allowed.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 15 and 17 have been considered but are moot in view of the new grounds of rejection.

#### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
1/7/05